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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WINDER, PATRICE L

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 11/06/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

pre

Office Action Summary

Application No.

09/454,689

Applicant(s)

KAPIL ET AL.

Examiner

Patrice Winder

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 19-24, 27-30, 32-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 19-24, 27-30, 32-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code 103 not included in this action can be found in a prior Office action.
2. Claims 1-4, 8, 19-24, 27-28, 30, 33, 35, 37, 39, 41 are rejected under 35 U.S.C. 103(a) as being anticipated by DeSimone et al., USPN 6,212,548 B1 (hereafter referred to as DeSimone) in view of Auerbach et al., USPN 6,549,937 B1 (hereafter referred to as Auerbach).
3. Regarding claim 1, DeSimone taught a method of communicating in a network having a plurality of communities each including a server (community=~~users~~ associated with a particular server, column 4, lines 4-8), comprising:
 - receiving from the server in a first community, a request including desired real-time, text-based messaging from a first community server to a second terminal coupled to the server in a second community (establishing chat participants list for associated server, claim 4); and
 - processing the request, by the server in the second community, to establish a real-time, text-based messaging session between the first and second terminals through the first and second community servers (forwarding messages of conversation to participant list, claim 4). DeSimone does not specifically teach a first community associated with a first service provider and a second community associated with a second, different service provider. However, Auerbach taught a first community associated with a first service provider and a second community associated with a

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second, different service provider (column 4, line 51 – column 5, line 48). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Auerbach's second, different service provider in DeSimone's instant messaging system would have improved system effectiveness. The motivation would have been to facilitate instant messaging between different service providers with different protocols (Auerbach, column 2, lines 24-32).

4. Regarding dependent claim 2, DeSimone taught further comprising determining if the second terminal has an established link with the second community server (determining intended participant, claim 5).

5. Regarding dependent claim 3, DeSimone taught further comprising sending a notification to the second terminal of the desired messaging session if the second terminal has an established link with the second community server (sending message to intended participant, claim 5).

6. Regarding dependent claim 4, DeSimone taught receiving an indication from the second terminal of whether the desired messaging session has been accepted (column 1, lines 65-67).

7. Regarding dependent claim 8, DeSimone taught establishing a chat session between the first and second terminals (column 2, lines 48-53).

8. Regarding claim 19, DeSimone taught a server for use in a communications system having a plurality of communities coupled by a network the server being associated with a first one of the communities (community = different users associated with different server, column 3, line 64 – column 4, line) and comprising:

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an interface unit adapted to receive a contact request over the network from an entity associated with another community, the entity not logged on to the server, the contact request indicating a request to establish a text-based messaging session with a destination terminal linked to the server (contact request = intended recipient list, claim 4); and

a controller adapted to send a notification to the destination terminal of the contact request (sending notification to intended participant, claim 5) and receive an indication from the destination terminal of acceptance of the contact request (column 1, lines 62-67). DeSimone does not specifically teach each community associated with a different service provider. However, Auerbach taught each community associated with a different service provider (column 4, line 51 – column 5, line 48). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Auerbach's different service provider for each community in DeSimone's instant messaging system would have improved system effectiveness. The motivation would have been to facilitate instant messaging between different service providers with different protocols (Auerbach, column 2, lines 24-32).

9. Regarding claim 20, DeSimone taught an article including one or more machine-readable storage media containing instructions for establishing a text-based messaging session between subscribers in a plurality of communities (community = different users associated with different server, column 3, line 64 – column 4, line 8), the instructions when executed causing a system in a first community associated with a first service provider to:

receive a request from a subscriber in a second community associated with a second service provider, the request indicating a desired text-based messaging session with a subscriber in the first community (receiving intended recipient list, claim 4);

notify the subscriber in the first community of the request (sending message to intended recipient, claim 5);

determine if the subscriber in the first community has accepted the request (column 1, lines 62-67); and

establish the text-based messaging session between the subscribers if the subscriber in the first community accepted (column 2, lines 48-53). DeSimone does not specifically teach each community associated with a different service provider.

However, Auerbach taught each community associated with a different service provider (column 4, line 51 – column 5, line 48). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Auerbach's different service provider for each community in DeSimone's instant messaging system would have improved system effectiveness. The motivation would have been to facilitate instant messaging between different service providers with different protocols (Auerbach, column 2, lines 24-32).

10. Regarding dependent claim 21, DeSimone taught the one or more storage media contain instructions that when executed cause the system to further send signaling to establish the text-based messaging session (column 2, lines 48-53).

11. Regarding dependent claim 22, DeSimone taught the text-based messaging session includes a chat session (column 2, lines 30-33, 48-49).

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12. Regarding dependent claim 23, DeSimone taught the one or more storage media contain instructions that when executed cause the system to create a controller object adapted to control the text-based messaging session (software instructions of server 210, column 4, lines 47-51).

13. Regarding dependent claim 24, DeSimone taught the one or more storage media contain instructions that when executed cause the system to: receive a request from a subscriber in a third community associated with a third service provider for a text-based messaging session (each server users may initiate chat session, column 5, lines 6-11, column 6, lines 57-61); and

establish the text-based messaging session among the subscribers in the first, second, and third communities (column 1, lines 10-15, column 4, lines 11-13, 48-51).

14. Regarding dependent claim 27, DeSimone taught receiving the request comprises receiving a request indicating a desired interactive, text-based chat session (column 2, lines 30-33, 48-49).

15. Regarding dependent claim 28, DeSimone taught the text-based messaging session comprises an interactive, text-based chat session (real-time chat session, column 2, lines 30-33, 48-49).

16. Regarding dependent claim 30, DeSimone taught the instructions when executed cause the system to establish the text-based messaging session by establishing an interactive, text-based chat session (column 2, lines 30-33, 48-49).

17. Regarding dependent claim 33, DeSimone taught providing a session object in the second community server, wherein receiving the request comprises receiving a

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request at the session object in the second community server from another session object in the first community server (receiving intended participant list, claim 5); and

the session object in the second community server exchanging messaging with the first community server to establish the real-time, text-based messaging session (claim 5).

18. Regarding dependent claim 35, DeSimone taught the interface unit is adapted to receive the contact request from a second server in the other community (column 15, lines 20-27).

19. Regarding dependent claim 37, DeSimone taught the controller comprises a session object (conversation object), the session object adapted to exchange

messaging with another session object in a second server in the other community to establish the text-based messaging session (message handling, column 5, lines 35-39, column 15, lines 27).

20. Regarding dependent claim 39, DeSimone taught the instructions when executed cause the system to receive the request at a first server in the system from a second server in the second community (claim 4).

21. Regarding dependent claim 41, DeSimone taught the instructions when executed cause the system to: provide a session object in the system (conversation object); and

cause the session object to exchange messaging with the second server to establish the text-based messaging session (message handling, column 5, lines 35-39, column 15, lines 27).

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22. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone and Auerbach as applied to claim 2, further in view of Ogle et al., USPN 6,430,604 B1 (hereafter referred to as Ogle).

23. Regarding dependent claim 5, DeSimone does not specifically teach sending a message to a predetermined communications device other than the second terminal if the second terminal does not have an established connection with the second community server. However, Ogle taught sending a message to predetermined communications device other than the second terminal if the second terminal does not have an established connection with the second community server (instant messaging system 403, column 9, lines 22-47). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Ogle's forwarding to a predetermined communications device in DeSimone's asynchronous text chat system would have to improve system effectiveness. The motivation would have been to enable DeSimone's messaging system to use alternative delivery mechanisms to prevent unnecessary loss of communication.

24. Regarding dependent claim 6, Ogle taught sending the messages includes sending to a communications device including at least one of a telephone, a pager and an electronic mail receiver (column 9, lines 40-47).

25. Claims 7 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone and Auerbach as applied to claims 2 and 19, respectively, further in view of Ishikawa, USPN 6,038,602 (hereafter referred to as Ishikawa).

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26. Regarding dependent claim 7, DeSimone does not specifically teach performing a reverse log on to the second terminal if the second terminal does not have an established link with the second community server. However, Ishikawa taught performing a reverse logon to the second terminal if the second terminal does not have an established link with the second community server (column 10, lines 5-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Ishikawa's reverse logon in DeSimone's asynchronous text chat system would have extended system functionality. The motivation would have been to eliminate the necessity for arranging network connections in advance.

27. Regarding dependent claim 29, DeSimone does not specifically teach the controller is adapted to further send messaging to perform a reverse log-on procedure with the destination terminal. However, Ishikawa taught the controller is adapted to further send messaging to perform a reverse log-on procedure with the destination terminal (column 10, lines 5-25). For motivation for combination see claim 7, above.

28. Claims 32, 34, 36, 38, 40, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone and Auerbach as applied to claims 1, 19, and 39, further in view of Busey et al., USPN 5,764,916 (hereafter referred to as Busey).

29. Regarding dependent claim 32, DeSimone taught providing a window for display at the first terminal, wherein receiving the request comprises receiving a message generated in response to a selection made in the window (column 6, lines 57-61). DeSimone does not specifically teach the window is a web page. However, Busey

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taught the window is a web page (column 1, lines 26-34, column 4, line 66 – column 5, line 38).

30. Regarding dependent claim 34, DeSimone taught providing a response, from the second community server, to the first terminal to present a window in a graphical user interface on the first terminal (column 1, lines 65-67); and

receiving a text message of the real-time, text-based messaging session originated from the window on the first terminal (column 9, lines 61-64). DeSimone does not specifically teach the window is a web page and the graphical user interface is a web browser. However, Busey taught the window is a web page and the graphical user interface is a web browser (column 1, lines 26-34, column 4, line 66 – column 5, line 38).

31. Regarding dependent claim 36, DeSimone taught the controller is adapted to communicate a window for display on the entity, the contact request comprising a message generated in response to user selection made in the window at the entity (column 6, lines 57-61). DeSimone does not specifically teach the window is a web page. However, Busey taught the window is a web page (column 1, lines 26-34, column 4, line 66 – column 5, line 38).

32. Regarding dependent claim 38, DeSimone taught the controller is adapted to communicate a response to the contact request to present a window in a graphical user interface at the entity (column 1, lines 65-67, column 5, lines 9-11), the interface unit adapted to further receive text messaging from the graphical user interface at the entity during the text-based message session (column 9, lines 61-64). DeSimone does not specifically teach the window is a web page and the graphical user interface is a web

browser. However, Busey taught the window is a web page and the graphical user interface is a web browser (column 1, lines 26-34, column 4, line 66 – column 5, line 38).

33. Regarding dependent claim 40, DeSimone taught the instructions when executed cause the system to provide a window for display at a subscriber terminal in the second community (column 1, lines 65-67), wherein the request received at the first server comprises messaging generated in response to selection made in the window displayed at the subscriber terminal in the second community (column 6, lines 57-61). DeSimone does not specifically teach the window is a web page. However, Busey taught the window is a web page (column 1, lines 26-34, column 4, line 66 – column 5, line 38).

34. Regarding dependent claim 42, DeSimone taught the instructions when executed cause the system to: communicate, in response to the request, a window for display in a graphical user interface at a subscriber terminal in the second community (column 1, lines 65-67, column 5, lines 9-11); and

receive messaging from the graphical user interface during the text-based messaging session (column 9, lines 61-64). DeSimone does not specifically teach the window is a web page and the graphical user interface is a web browser. However, Busey taught the window is a web page and the graphical user interface is a web browser (column 1, lines 26-34, column 4, line 66 – column 5, line 38).

35. It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Busey's web page and web browser in DeSimone's asynchronous text chat system would have improved system effectiveness.

The motivation would have to provide an avenue for widespread use of DeSimone's asynchronous text chat system.

Response to Arguments

36. Applicant's arguments filed September 4, 2003 have been fully considered but they are not persuasive.

37. Applicant argues – "This necessarily means that DeSimone does not teach any of the following elements of claim 1: (1) receiving, from a server in a first community ... (2) processing the request, ..."

a. Although, applicant statement has been fully considered it does not address the rejection of record. The rejection of record states for claim 1 – [DeSimone taught] receiving from the server in a first community, a request including desired real-time, text-based messaging from a first community server to a second terminal coupled to the server in a second community (establishing chat participants list for associated server, claim 4); and processing the request, by the server in the second community, to establish a real-time, text-based messaging session between the first and second terminals through the first and second community servers (forwarding messages of conversation to participant list, claim 4).

The rejection does not rely upon DeSimone to teach a server in a second community associated with a second, different service provider. Auerbach is

relied upon for this teaching. Therefore, the combination of DeSimone and Auerbach are relied upon to teach the claimed limitations.

38. Applicant argues – “Auerbach also fails to teach either of the two elements listed above.”

b. The rejection does not rely upon Auerbach teaching the two elements in question. The rejection relies on Auerbach to teach a communication system, which allows individuals to engage in an instant messaging session even if the subscribers have different service providers (column 2, lines 9-15). To reiterate the rejection states - Auerbach taught a first community associated with a first service provider and a second community associated with a second, different service provider (column 4, line 51 – column 5, line 48).

39. Applicant argues – “This architecture of Auerbach is clearly distinguished by the elements of claim 1. Note that claim 1 recites receiving a request from a server in a first community associated with a first service provider, and processing the request by a *server* in a *second* community associated with a second different service provider, to establish a real-time text based messaging session.”

c. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

d. Applicant is arguing the references individually, however, in doing so applicant's arguments in general do not address the rejection made utilizing the prior art of record.

40. Applicant argues – "In contrast, in Auerbach, a common conversion platform 112 is used to perform processing of a request from the client 102. The client 102 and conversion platform are part of the same system 100 on which an application program 104 (providing a user interface to the user) resides. Thus, processing of a request to establish a chat session is performed by a server associated with a given community – the processing is performed by a common conversion platform residing on the same system as the client 102) that converts between a first-format and each of multiple formats that are recognizable by respective different service providers."

e. Auerbach also taught utilizing the common conversion platform 112 to communicate with a particular service provider, i.e. the improvement of Auerbach invention. As applicant has noted in great depth the conversion platform enable the client to generate/receive communication in the multiple protocols of the service protocol. However, applicant's analysis of Auerbach invention loses sight of the fact that the underlying request/response being converted is to/from a service provider from a different community.

41. Applicant argues – "There also is not motivation to combine the teachings of DeSimone and Auerbach, as there is not need within the DeSimone system of performing real-time, text based messaging sessions between terminals associated with different community servers. DeSimone teaches only one service processor. Therefore,

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DeSimone would have no need for the common conversion platform 112 of Auerbach, as DeSimone does not have the incompatibility issues discussed in Auerbach.”

f. DeSimone specifically taught a real-time, text based messaging system where conversations are conducted by a plurality of terminals through a plurality of processors, i.e. more than one (column 4, lines 4-11).

g. Applicant has overlooked that Auerbach’s common conversion platform is utilized to enable real-time text based messaging sessions between terminals associated with different community servers in a transparent manner (column 8, lines 39-49). Such also provides motivation for the DeSimone-Auerbach combination.

42. Applicant argues – “Again, claim 19 recites a server of a first community receiving a contact request from an entity associated with another community, and a controller to send a notification of the contact request and to receive an indication of the acceptance of the contact request. The hypothetical combination of DeSimone and Auerbach does not teach or suggest these elements.”

h. DeSimone taught conversations are started after “notification” that a “contact request” is accepted (column 6, line 59 - column 7, line 53). Further, DeSimone taught the conversations are conducted between the terminals in question through a network attached to at least one server. One of more of the plurality of terminals is connected to a group of servers (column 3, lines 43-49, column 3, line 64 – column 4, line 2, column 4, lines 8-11). When the

conversations occur between different servers (i.e. different communities) the "contact request" and "notification" are transmitted between communities.

i. Also, Auerbach taught the need for a communication system that will allow participants to engage in instant messaging session even if the participants have different service providers (column 2, lines 9-15). A conventional instant messaging system begins conversations by a "contact request"/"notification exchange". Auerbach taught the advantages of his invention in an instant messaging system where multiple participants have multiple service providers (column 8, lines 45-49).

43. Applicant argues – "The processing of a request for a desired text-based messaging session by a system in one community ... received from another community is not taught or suggested by the hypothetical combination of DeSimone and Auerbach.

j. DeSimone taught a network connecting plurality of terminals wherein conversations are conducted between the terminals. The terminals themselves are either connected to the same server or one of more of the plurality of terminals is connected to a group of servers (column 3, lines 43-49, column 3, line 64 – column 4, line 2, column 4, lines 8-11). Therefore, DeSimone taught at least communication in a text-based messaging session by a system in one community (i.e. terminals attached to one server) and another community (i.e. terminals attached to another server).

k. Further, Auerbach taught the need for a communication system that will allow participants to engage in instant messaging session even if the participants

have different service providers (column 2, lines 9-15). Auerbach taught processing a request (not the conversion) for a desired text-based messaging session by a system in one community (service provider) received from another community (service provider) (for example request to change state, column 7, lines 1-3, 29-64).

Conclusion

44. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

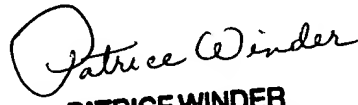
~~A shortened statutory period for reply to this final action is set to expire THREE~~
MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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45. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is (703) 305-3938. The examiner can normally be reached on Monday-Friday from 10:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam, can be reached on (703) 308-6662. The fax phone number(s) for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


PATRICE WINDER
PRIMARY EXAMINER